# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Paul M. Brennan, et al.

Serial No. : 09/739,708

Filed : December 20, 2000

For : FALLBACK TO MESSAGE COMPOSE ON SYNCHRONOUS CALL ATTEMPT

Group No. : 2642

Examiner : T.P. Knowlin

**RECEIVED**

MAY 0 5 2004

Technology Center 2600

**MAIL STOP APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

## APPELLANTS' BRIEF ON APPEAL

This Brief is submitted in triplicate on behalf of Appellants for the application identified

above. A check is enclosed for the $330.00 fee for filing a Brief on Appeal. Please charge any

additional necessary fees to Deposit Account No. 50-0208.

## REAL PARTY IN INTEREST

The real party in interest for this appeal is the assignee of the application, NORTEL NETWORKS LTD.

## RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application which are currently pending.

## STATUS OF CLAIMS

Claims 1–31 are pending in the present application. Claims 1–31 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,818,903 to *Han et al* in view of U.S. Patent No. 5,668,880 to *Alajajian*. The rejection of pending claims 1–31 is appealed.

## STATUS OF AMENDMENTS

No amendments to the claims were submitted following the final Office Action mailed September 24, 2003.

## SUMMARY OF THE INVENTION

The present invention relates to messaging in communications systems. When a caller attempts a call to a party that is dropped due, for example, to unavailability of the called party, the calling party may wish to leave a message but feel rushed or be unable to navigate the user interface. Specification, page 1, lines 7–19. Messaging systems for sending a message without initiating a call typically require the caller to know a number for the called party, or use an intermediate directory. Specification, page 1, lines 20–30.

In the present invention, a supervised call is monitored to determine if the call is answered. Specification, page 6, lines 9–20. If the call is answered, a determination is made as to whether the call was answered by a natural person or by an answering or messaging system. Specification, page 6, line 21 through page 7, line 5. If the call is not answered, or is answered by an answering or messaging system, then a communications address for the called party is determined and the call is dropped, either before or after the communications address is determined. Specification, page 7, lines 7–19. The communications address is determined by using the called party's number or other information about the called party as a query in a database. Specification, page 11, lines 11–32. The calling party is allowed to compose a message, which is delivered to the communications address for the called party. Specification, page 7, line 20 through page 8, line 14.

## ISSUES ON APPEAL

Claims 1–31 were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. The sole issue on appeal is whether claims 1–31 were properly rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*.

## GROUPING OF CLAIMS

Claims 1–31 are pending in the present application. Claims 1–31 were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. For purposes of this appeal, the pending, rejected claims will be grouped together as follows:

Group A – claims 1–23 and 30–31;

Group B – claim 6;

Group C – claims 8 and 21;

Group D – claim 9;

Group E – claims 10 and 22;

Group F – claims 13 and 24; and

Group G – claims 27–29.

Groups A–G stand or fall independently. Patentability of the claims within each group is argued separately below.

## ARGUMENT

### Group A (Claims 1–23 and 30–31)

Claims 1–23 and 30–31 of Group A were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. These claims are properly grouped together and considered separately from the claims of Groups B–G since a decision with respect to the claims of Group A may obviate the need for consideration of Groups B–F and since the claims of Group A contain common limitations distinguishing the claims over the cited prior art that differ from the limitations in the claims of Group G distinguishing those claims over the cited prior art.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-123 (8th ed. rev. 1 February 2003). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be described, shown or suggested in the prior art, and not based on applicant's disclosure. MPEP § 2142 at p. 2100-124.

Claims 1, 16 and 30 of Group A each recite receiving, after a synchronous call attempt to a called party is dropped, a message composed by the calling party. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination. Assuming *arguendo* that *Han et al* describes dropping a call attempt and *Alajajian* describes receiving messages from other parties as asserted in the final Office Action, no motivation or incentive has been identified for specifically receiving a message from a calling party after a synchronous call attempt from the called party is dropped.

Claims 1, 16 and 30 of Group A also each recite determining at least one communication address related to the called party. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination. The cited portion of *Han et al* describes determining an identification number for a mobile station within a CDMA system:

> As shown in FIG. 7, the tones of various frequencies are combined into three
> tones and are transmitted from the call outgoing mobile station. Namely, three digits

identification number and single tone number are combined. Only the call outgoing mobile station transmits an identification number, and the call incoming mobile station receives an identification number, and transmits a response. The call outgoing mobile station starts transmitting the identification number tone after transmitting the tone corresponding to the frequency of 900 Hz which indicates a state that the tone is transmitted. The transmission time of an individual tone is 100 msec. The tone corresponding to the response of the call incoming mobile station is 900 Hz. The call outgoing/incoming mobile station concurrently transmits the single tone for a predetermined time after the identification number is transmitted, and the transmission time is determined by the user.

*Han et al*, column 6, lines 28–44. However, *Han et al* contains no teaching or suggestion that the identification number is used to address the mobile station, as opposed to, for example, registering the mobile station on the CDMA system for mobile communication services.

## Group B (Claim 6)

Claim 6 of Group B was rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. This claim is properly considered separately from the claims of Groups A and C–G since the claim contains an element/feature distinguishing the claim over the prior art that is not described, shown or suggested in the claims of Groups A and C–G: dropping the synchronous call attempt prior to determining a communications address for the called party.

Claim 6 of Group B recites dropping the synchronous call attempt prior to determining a communications address for the called party. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination.

## Group C (Claims 8 and 21)

Claims 8 and 21 of Group C were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. These claims are properly grouped together and considered

separately from the claims of Groups A–B and D–G since the claims contain a common element/feature distinguishing the claims over the prior art that is not described, shown or suggested in the claims of Groups A–B and D–G: a communications address for the called party comprising one of a telephone number, pager number, e-mail address, voice messaging address, mobile phone number and Internet instant messaging address.

Claims 8 and 21 of Group C each recite a communications address for the called party comprising one of a telephone number, pager number, e-mail address, voice messaging address, mobile phone number and Internet instant messaging address. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination. *Han et al* does not teach or suggest that the identification number for the mobile station is one of a telephone number, pager number, e-mail address, voice messaging address, mobile phone number and Internet instant messaging address.

## Group D (Claim 9)

Claim 9 of Group D was rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. This claim is properly considered separately from the claims of Groups A–C and E–G since the claim contains an element/feature distinguishing the claim over the prior art that is not described, shown or suggested in the claims of Groups A–B and E–G: using the called party's telephone number in a query to a database of communication addresses, to determine the communication address for the called party.

Claim 9 of Group D recites using the called party's telephone number in a query to a database of communication addresses, to determine the communication address for the called party. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination.

### Group E (Claims 10 and 22)

Claims 10 and 22 of Group E were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. These claims are properly grouped together and considered separately from the claims of Groups A–D and F–G since the claims contain a common element/feature distinguishing the claims over the prior art that is not described, shown or suggested in the claims of Groups A–D and F–G: using information about the called party in a query to a database of communication addresses, to determine the communication address for the called party.

Claims 10 and 22 of Group E each recite using information about the called party in a query to a database of communication addresses, to determine the communication address for the called party. Such a feature is not described, shown or suggested in the cited references, taken alone or in combination.

### Group F (Claims 13 and 24)

Claims 13 and 24 of Group F were rejected under 35 U.S.C. § 103(a) as being obvious over *Han et al* in view of *Alajajian*. These claims are properly grouped together and considered separately from the claims of Groups A–E and G since the claims contain a common element/feature

distinguishing the claims over the prior art that is not described, shown or suggested in the claims

of Groups A–E and G: presenting a calling party with a list of messaging options based on a plurality

of communication addresses related to the called party.

Claims 13 and 24 of Group F each recite presenting a calling party with a list of messaging

options based on a plurality of communication addresses related to the called party. Such a feature

is not described, shown or suggested in the cited references, taken alone or in combination. The

cited portion of *Alajajian* merely describes, separately, displaying menus for formulating messages

and call types associated with broadcast addresses, without specifically teaching or suggesting

displaying a specific menus based on the broadcast addresses for a recipient.

## Group G (Claims 27–29)

Claims 27–29 of Group G were rejected under 35 U.S.C. § 103(a) as being obvious over *Han*

*et al* in view of *Alajajian*. These claims are properly grouped together and considered separately

from the claims of Groups A–F since the claims contain a common element/feature distinguishing

the claims over the prior art that is not described, shown or suggested in the claims of Groups A–F:

detecting, during a synchronous call attempt, an indication from the calling party that the calling

party wishes to send a message.

Claim 27 of Group G recites detecting, during a synchronous call attempt, an indication from

the calling party that the calling party wishes to send a message. Such a feature is not described,

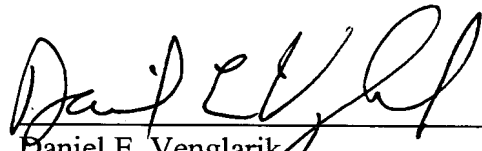shown or suggested in the cited references, taken alone or in combination.

## CONCLUSION

None of the cited references, taken alone or in combination, depict or describe all features

of the invention claimed in Groups A–G.  Therefore, the rejection under 35 U.S.C. § 103 is

improper.  Applicant respectfully requests that the Board of Appeals reverse the decision of the

Examiner below rejecting pending claims 1–31 in the application.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 4 - 29 - 04

Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *dvenglarik@davismunck.com*

## APPENDIX TO APPELLANT'S BRIEF ON APPEAL
### PENDING CLAIMS ON APPEAL

1.  A method for handling an unsuccessful synchronous call attempt from a calling party to a called party, said method comprising:

    monitoring a synchronous call attempt from said calling party to said called party;

    determining at least one communication address related to said called party;

    dropping said synchronous call attempt to said called party;

    after dropping said synchronous call attempt to said called party, receiving a message composed by the calling party; and

    sending said message to said determined communication address.

2.  The method of claim 1, further comprising determining that said synchronous call attempt to said called party is unsuccessful.

3.  The method of claim 2, wherein said determining that said synchronous call attempt to said called party is unsuccessful comprises detecting an indication from the calling party that said synchronous call attempt to said called party is unsuccessful.

4.  The method of claim 3, wherein said indication comprises said calling party pressing a predetermined key or keys on a communication device.

5.      The method of claim 3, wherein said indication comprises said calling party using a vocal command.

6.      The method of claim 1, wherein said dropping occurs prior to said determining said at least one communication address.

7.      The method of claim 1, wherein said dropping comprises disconnecting.

8.      The method of claim 1, wherein said at least one communication address comprises at least one of a telephone number, pager number, e-mail address, voice messaging address, mobile phone number, and Internet instant messaging address.

9.      The method of claim 1, wherein said determining at least one communication address comprises using said called party's telephone number in a query to at least one database for communication addresses for said called party.

10.     The method of claim 1, wherein said determining at least one communication address comprises using information about said called party in a query to at least one database to obtain other information about said called party.

11.     The method of claim 10, wherein said other information about said called party is used in a query to at least one database to obtain further information about said called party.

12.     The method of claim 10, wherein said information about said called party comprises name and communication addresses.

13.     The method of claim 1, wherein said receiving a message composed by a calling party comprises:

where said at least one communication address related to the called party comprises a plurality of communication addresses, presenting said calling party with a list of messaging options based on said plurality of communication addresses;

allowing the calling party to select a messaging option for use; and

commencing a message compose session related to said selected messaging option and pre-filling a communication address for said message with a communication address related to said messaging option.

14.     The method of claim 13, further comprising determining said called party's communication addresses that are available for use.

Page A3

15.     The method of claim 14, wherein said determining the called party's addresses that are available for use comprises comparting the determined called party's addresses with the message compose capability of a communications device of said calling party.


16.     A computer readable medium containing computer executable code which adapts a processor for a communication system to:

        monitor a synchronous call attempt from said calling party to said called party;

        determine at least one communication address related to said called party;

        drop said synchronous call attempt to said called party;

        after dropping said synchronous call attempt to said called party, receive a message composed by a calling party; and

        send said message to said determined communication address.


17.     The computer readable medium of claim 16, further adapting a processor for a communication system to determine that said synchronous call attempt to said called party is unsuccessful.


18.     The computer readable medium of claim 17, wherein said determining that said synchronous call attempt to said called party is unsuccessful comprises detecting an indication from the calling party that said synchronous call attempt to said called party is unsuccessful.

19.     The computer readable medium of claim 18, wherein said indication comprises said calling party pressing a predetermined key or keys on a communication device.

20.     The computer readable medium of claim 18, wherein said indication comprises said calling party using a vocal command.

21.     The computer readable medium of claim 16, wherein said at least one communication address comprises at least one of a telephone number, pager number, e-mail address, voice messaging address, mobile phone number, and Internet instant messaging address.

22.     The computer readable medium of claim 16, wherein said determining at least one communication address comprises using information about said called party in a query to at least one database to obtain other information about said called party.

23.     The computer readable medium of claim 22, wherein said other information about said called party is used in a query to at least one database to obtain further information about said called party.

ATTORNEY DOCKET NO. 13053STUS01U (NORT10-00100)
U.S. SERIAL NO. 09/739,708
PATENT

24.     The computer readable medium of claim 16, wherein said receive a message composed by a calling party comprises:

where said at least one communication address related to the called party comprises a plurality of communication addresses, presenting said calling party with a list of messaging options based on said plurality of communication addresses;

allowing the calling party to select a messaging option for use; and

commencing a message compose session related to said selected messaging option and pre-filling a communication address for said message with a communication address related to said messaging option.

25.     The computer readable medium of claim 24, further comprising determining said called party's communication addresses that are available for use.

26.     The computer readable medium of claim 25, wherein said determining the called party's addresses that are available for use comprises comparing the determined called party's addresses with the message compose capability of a communications device of said calling party.

Page A6

27.    A method for handling a synchronous call attempt from a calling party to a called

party, said method comprising:

monitoring a synchronous call attempt from said calling party to said called party;

detecting during said synchronous call attempt an indication from said calling party

that said calling party wishes to send a message;

determining at least one communication address related to said called party;

receiving a message composed by said calling party; and

sending said message to said determined communication address.

28.    The method of claim 27, wherein said detecting comprises detecting said calling party

pressing a predetermined key or keys on a communication device.

29.    The method of claim 27, wherein said detecting comprises detecting said calling party

using a vocal command.

30.    A system for handling an unsuccessful synchronous call attempt from a calling party
to a called party, said system comprising:

monitoring means for monitoring a synchronous call attempt from said calling party
directed to said called party;

detection means for determining that said synchronous call attempt from said calling
party to said called party is unsuccessful;

addressing means for determining at least one address for said called party;

dropping means for dropping said synchronous call attempt to said called party;

message means for receiving a message composed by said calling party after dropping
said synchronous call attempt to said called party; and

sending means for sending said message to said address determined by said
addressing means.

31.    The system of claim 30, wherein said addressing means comprises:

at least one database containing said called party's address information;

database query means for querying said database for said called party's address
information; and

data communication means for providing said called party's address information to
said message means.